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SCHIFF HARDIN, LLP			LIOU, ERIC	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/797,838	Applicant(s) REISINGER, KATRIN	
	Examiner Eric Liou	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1-4 remain pending and are presented for examination.

Response to Arguments

2. Applicant's arguments filed 2/11/08 have been fully considered but they are not persuasive.
3. Applicant argues, "[T]he Ulvr et al reference, like the Schuricht et al reference, has a filing date and a publication date that are significantly earlier than the relatively recent conception and usage of product codes, and therefore the Ulvr et al references does not and cannot provide any guidance to a person of ordinary skill in the field of designing postage meters with regard to the incorporation of an automatic designation of a product code in such a postage meter." However, Applicant's specification does not provide a special definition for the term "product code". Applicant merely provides examples of "product codes" that are used in various countries. Therefore, the term "product code" is not limited to the recent conception and usage of "product codes" in the context of the examples as described by Applicant. As such, any argument regarding the date of the cited references with respect to Applicant's invention is not a particularly relevant issue at hand. The Examiner notes, *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) ("The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim."). In addition, other court decisions have indicated that if an inventor is relying on a

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special meaning for terms appearing in the claims, then the special meaning must be clearly written in the specification. See *In re Thrift*, 63 USPQ2d 2002 (Fed. Cir. 2002) (“Although an applicant may be his own lexicographer...nothing in the specification defines the phrase “speech user agent” differently from its ordinary meaning.”). Thus, while Applicant may have a specific and particular “product code” in mind, the specification fails to define the term “product code” to be this particular code with exactness and precision. Moreover, USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. See *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Also see *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow...”) and *In re Pearson*, 181 USPQ 641 (CCPA 1974) (Claims in a pending application should be given their broadest possible interpretation). Using a broad and reasonable interpretation, one of ordinary skill in the art would recognize that the term “product code” can be any code that relates to a particular type of service in the mail industry. Schuricht teaches a rate code (product code) that pertains to the type/class of service desired (Schuricht: Figs. 2B and 2C; col. 3, lines 19-59). These rate codes and corresponding rate tables can be for a carrier postal service (Schuricht: col. 4, lines 1-3). Schuricht does not explicitly teach country-specific codes. However, Ulvr teaches using country-specific codes for mail. The Examiner maintains that it is the combination of Schuricht in view of Ulvr that teaches all of the limitations of claim 1 as written.

4. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

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long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuricht et al., U.S. Patent No. 5,040,132 in view of Ulvr et al., U.S. Patent No. 5,602,382.

7. **As per claim 1**, Schuricht teaches a mail-processing device comprising:

a microprocessor (Schuricht: Figure 1, "1"; col. 2, lines 28-39);

a keyboard with operating elements connected to said microprocessor for entering shipping information into said microprocessor (Schuricht: Figure 1, "2"; col. 1, lines 51-53);

a working memory accessible by said microprocessor containing mail-item-related data values (Schuricht: Figure 1, "6" and Figure 2);

a programmable memory and a program memory accessible by said microprocessor (Schuricht: Figure 1, "6"; col. 2, lines 40-44);

in at least one of said program memory and said programmable memory, a first memory area containing a program that evaluates said mail-item-related data values stored in the working

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memory to cause said mail-item-related data values to be permanently or temporarily stored (Schuricht: col. 2, lines 37-44), a second memory area containing a first table for indices respectively assigned to different postal authority-defined product codes, said product codes being ascendingly or consecutively stored in said table in a column and said table having a second column, in parallel with said first column, containing indices for different product descriptions (Schuricht: Figures 2B and 2C; col. 1, lines 24-27, “parcel post”; col. 3, lines 19-59 – The Examiner notes, the different shipping modes and rate codes to represent the different products. The Examiner further notes, it is in the basic knowledge of the skilled artisan that a rate table contains multiple columns and indices. The applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein.), and a third memory range for storage of a further table for said product descriptions respectively assigned to said indices in said second column (Schuricht: Figure 2A; The Examiner notes, a further table for the said product descriptions can be the receiver address and location code.); and

said microprocessor being programmed by said program for evaluating the mail-item-related data values stored in the working memory by accessing said table containing said first and second columns to automatically determine a product code and a product description for said service product (Schuricht: Figures 2 and 12; col. 1, lines 35-38; col. 4, lines 52-68 - col.5, lines 1-7), and to supply as an output a text for said product description for generating a printout

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thereof (Schuricht: col. 3, lines 50-55; col. 4, lines 38-51, “Each information block 16 contains the control commands and text information data required for causing the printer to print out the form or forms required for a certain shipping mode.”).

8. Schuricht does not teach country-specific codes.

9. Ulvr teaches country-specific codes (Ulvr: Fig. 5; col. 9, lines 24-54, “country code”)

10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schuricht to have included country-specific codes as taught by Ulvr for the advantage of complying with the postal code requirements of other countries when necessary during mail processing (Ulvr: col. 9, lines 53-54).

11. **As per claim 2**, Schuricht in view of Ulvr teaches the mail-processing device as claimed in claim 1 as described above. Schuricht further teaches the said microprocessor is programmed to determine the index for the product code and to locate the index in said further table for said product description (Schuricht: col. 3, lines 60-68; col. 4, lines 1-15).

12. **As per claim 3**, Schuricht in view of Ulvr teaches the mail-processing device as claimed in claim 1 as described above. Schuricht further teaches a fourth memory area for storage of an additional further table containing text strings assigned to the respective indices, and wherein said microprocessor is programmed by said program to determine a text string from said additional further table dependent on shipping parameters for said service product and to supply said text strings in said output (Schuricht: Figure 2C; column 4, lines 30-37 – The Examiner interprets the supplement portion within memory 15 to be a fourth memory area, which is separate from the rate table. The Examiner notes, the information located in memory 15 (Figure 2C) is supplied to a printer (Schuricht: col. 4, lines 46-51)).

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13. **As per claim 4**, Schuricht in view of Ulvr teaches the mail-processing device as claimed in claim 1 as described above. Schuricht further teaches the program memory is a permanent memory and wherein said programmable memory is a semi-permanent memory (Schuricht: col. 9, lines 30-43).

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

The Examiner has cited particular portions of the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the Applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or

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part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Liou whose telephone number is (571)270-1359. The examiner can normally be reached on Monday - Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric Liou/
Examiner, Art Unit 3628

/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628

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